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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,517	06/30/1999	ROBERT BURNETT	A7489	8018

7590

12/12/2002

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EXAMINER

FERRIS, DERRICK W

ART UNIT

PAPER NUMBER

2663

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No.

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 12/6/02 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on September 8, 2000 (see 65 Fed. Reg. 54603, Sept. 8, 2000, and 1238 O.G. 77, Sept. 19, 2000). In order for the amendment to be compliant, applicant must supply the following omissions or corrections in response to this notice.

THE FOLLOWING ITEMS ARE REQUIRED FOR COMPLIANCE WITH RULE 1.121 (APPLICANT NEED NOT RE-SUBMIT THE ENTIRE AMENDMENT):

- ☐ 1. A clean version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(ii).
- ☐ 2. A marked-up version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(iii).
- ☒ 3. A clean version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(i).
- ☐ 4. A marked-up version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(ii).

Explanation:

You have two marked-up versions of the amended claims. (2, 9, 14 and 15).

(LIE: Please provide specific details for correction to assist the applicant. For example, "the clean version of claim 6 is missing.")

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/dcom/olia/pbg/sampleaf.pdf>. A condensed version of a sample amendment format is attached.

- ☐ **PRELIMINARY AMENDMENT:** Unless applicant supplies the omission or correction to the preliminary amendment in compliance with revised 37 CFR 1.121 noted above within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.
- ☐ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE MONTH or THIRTY DAYS from the mailing of this notice, whichever is longer, within which to supply the omission or correction noted above in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Joy Dobbs 12/12/02
Legal Instruments Examiner (LIE)

Changes to the Patent Rules

October 24, 2000

Volume 1, Issue 3

This is the third in a series of Patent News Bulletins to assist you in keeping up to date with significant rule changes which affect your area. Keep this copy to use as a bookmark for your present MPEP, or view this bulletin again on the USPTO Website.

Simplified Amendment Practice.

Replacement paragraphs/sections/claims to be used. 37 CFR 1.121



The rule package "Changes to the Patent Business Rules - Final Rule," published in the Federal Register on September 8, 2000, 65 Fed. Reg. 54603 (Sept. 8, 2000), and the Official Gazette on September 19, 2000, 1238 Off. Gaz. Pat. & Tm. Office 77 (September 19, 2000). The PBG 2000 package makes a number of revisions to Title 37.

The entire final rule may be found at the USPTO Website at http://www.uspto.gov/patent/office/decisions/patent_rules.html.

Areas and individuals primarily affected by this rule change include:
(1) Patent Examiners and Tech Support Staff in the Technology Centers
(2) Office of Patent Publication

Any questions related to this change in practice should be directed to Joe Naravage, Special Projects Exr., (703-305-1795) OPLA.

Mandatory compliance with the revised rule is not required until March 1, 2001. It is suggested that applicants adopt the revised procedures on or after November 7, 2000, in order to adjust to the changes in amendment practice.

Under the new amendment practice, amendments to the specification must be made by the submission of clean new or replacement paragraph(s), section(s), specification, or claim(s). This practice will provide a specification (including claims) in clean, or substantially clean, form that can be effectively captured and converted by optical character recognition (OCR) scanning during the patent printing process.

The new practice requires applicant to provide, in addition to the clean version of a replacement paragraph/section/claim, a marked-up version using applicant's choice of a conventional marking system to indicate the changes, which will aid the examiner in identifying the changes that have been made. The marked-up version must be based on the previous version and indicate (by markings) how the previous version has been modified to produce the clean version submitted in the current amendment. The term "previous version" means the version of record in the application as originally filed or from a previously entered amendment.

The following format is suggested in an amendment paper: (1) a clean version of each replacement paragraph/section/claim with clear instructions for entry; (2) starting on a separate page, any remarks, arguments; (3) 37 CFR 1.111; and (3)

starting on a separate page, a marked-up version entitled "Version with markings to show changes made."

Applicants will also be able to submit a clean set of all pending claims, consolidating all previous versions of pending claims from a series of separate amendments into a single clean version in a single amendment paper. This submission of a clean version of all of the pending claims will be construed as directing the cancellation of all previous versions of any pending claims. No marked-up version will be required to accompany the clean version where no changes other than the consolidation are being made.

Amendment by paragraph/claim replacement in clean form.

The amended rule encourages issuance of applications with an examiner's amendment without practitioners/applicants having to file a formal amendment. Additions or deletions of subject matter in the specification, including

the claims, may continue to be made in an examiner's amendment at the time of allowance by instructions to make any change at a precise location in the specification or the claims. An examiner's amendment may incorporate a printed copy of a fax or e-mail amendment submitted by applicant. Only that part of the e-mail or fax directed to a clean version, or a portion of, a paragraph/claim to be added should be printed and attached to the examiner's amendment, with a paper copy of the entire e-mail or fax being entered in the file. The electronic version of the e-mail is not required to be saved once the printed e-mail (and any attachments) becomes part of the application file record.

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MPEP 714 & 1302.04

A Brief Summary of Some Significant Rule Changes

*Unless otherwise specified in the rule, the effective date for the **PBG-FINAL RULE** is November 7, 2000.

Amendment Practice (37 CFR 1.121)

- Specification/Claims
 - Amendment by paragraph replacement or rewritten claim in clean form
 - Marked-up version showing changes must be supplied

See § 1.121 Slides on **PBG-FINAL RULE** Webpage for suggested amendment **FORMAT** (Optional now; mandatory March 1, 2001)

Small Entity Status (37 CFR 1.27) - **FORMS NO LONGER REQUIRED** (Eff. Sept. 8, 2000):

- Mere written assertion (e.g., use check box on Application Transmittal Forms) is acceptable

Abstract and Title Length (37 CFR 1.72)

- **Abstract** now limited to 150 words (PBG)
- **Title** now limited to 500 characters (AIPA)

Application Data Sheet (ADS) (37 CFR 1.76) **NEW**

- Use of ADS encouraged for more accurate capture of bibliographic data. Data in ADS not needed in declaration.

After Allowance Practice (37 CFR 1.85(c) and 1.136)

- No extensions of time permitted to file corrected or formal drawings

Elimination of Issue Fee Preauthorizations (37 CFR 1.311)

- Preauthorizations prior to Notice of Allowance no longer permitted

Rocket Docket Established for Designs (37 CFR 1.155)

- Extra submissions plus \$900 fee is required

Proof of Authority of Legal Representative (37 CFR 1.44) **THIS RULE HAS BEEN DELETED.** (Eff. Sept. 8, 2000):

- Oath/Dec. (§1.63) should identify legal rep for deceased/incapacitated inventor.

Parts of Applications on CD-R or CD-ROM (37 CFR 1.52(e), 1.58, 1.96 & 1.821)

- Large tables, computer program listings, and bio-sequences now allowed on CD

Patent Business Goals Final Rule

65 Fed. Reg. 54604 (September 8, 2000)

1238 Off. Gaz. Pat. Office 11 (September 19, 2000)



USPTO's **PBG-FINAL RULE** webpage has helpful related information at one location:
<http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>

This site includes:
a Listing of Affected Rules,
Training & Implementation
Materials including Training
Slides, Q & A's, Summaries,
Effective Date Chart, Forms
Changed by Recent Rules, etc.

Contact:

Bob Spar (703) 308-5107 or
Hiram Bernstein (703) 305-8713
for any PBG Change.

Joe Narcavage (703) 305-1795
for 37 CFR 1.121
Amendment Practice Changes

Eugenia Jones (703) 306-5586
for 37 CFR 1.27 Small Entity
Changes

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